

ESTTA Tracking number: **ESTTA228544**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	Zimmer, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	345 Main Street Warsaw, IN 46580 UNITED STATES		

Attorney information	Christina L. Brown McDonnell Boehnen Hulbert & Berghoff LLP 300 South Wacker Drive Suite 3100 Chicago, IL 60606 UNITED STATES brownc@mbhb.com, gutwaks@mbhb.com, PSGDocket@mbhb.com Phone:312/913-0001
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### Registrations Subject to Cancellation

Registration No	2750144	Registration date	08/12/2003
Registrant	ENCORE MEDICAL ASSET CORPORATION P.O. Box 530759 Henderson, NV 89053 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 010. First Use: 2002/06/05 First Use In Commerce: 2002/06/05 All goods and services in the class are cancelled, namely: Orthopedic prostheses, namely, joint implants
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### Grounds for Cancellation

Genericness	Trademark Act section 23		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	2859530	Registration date	07/06/2004
Registrant	ENCORE MEDICAL ASSET CORPORATION P.O. Box 530759 Henderson, NV 89053 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 010. First Use: 2002/06/05 First Use In Commerce: 2002/06/05 All goods and services in the class are cancelled, namely: Orthopedic prostheses, namely, joint implants
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Attachments	Petition to Cancel.pdf ( 5 pages )(154154 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Christina L. Brown/
Name	Christina L. Brown
Date	08/05/2008

Zimmer, Inc.,	)	PETITION FOR CANCELLATION
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. _____
	)	
Encore Medical Asset Corporation,	)	Registration Nos. 2,750,144 and
	)	2,859,530
Registrant	)	

**PETITION FOR CANCELLATION PURSUANT TO 37 C.F.R. § 2.111**

Upon information and belief, the name and address of the current owner of the registrations is Encore Medical Asset Corporation, having an address at P.O. Box 530759, Henderson, NV 89053.

On information and belief, Encore Medical Asset Corporation's current correspondence address is as follows:

Harry L. Zimmerman  
Encore Medical Asset Corporation  
9800 Metric Boulevard  
Austin, TX 78758

## **I. Background**

As grounds for this Petition, Zimmer, Inc. ("Zimmer") alleges that:

1. On information and belief, Registration Nos. 2,750,144 and 2,859,530 are owned by Encore Medical Asset Corporation ("Encore Medical"), a Nevada corporation.
2. Registrant's application for Registration No. 2,750,144 was filed on November 15, 2002 and issued on August 12, 2003, for "orthopedic prostheses, namely, joint implants" in International Class 010.
3. Registrant's application for Registration No. 2,859,530 for the mark **Reverse** was filed on January 9, 2003 and issued on July 6, 2004, for "orthopedic prostheses, namely, joint implants" in International Class 010.

## **II. Standing**

4. Zimmer has been actively engaged in research, development, and marketing activities using the word "reverse" in connection with prosthetic shoulder devices.
5. Zimmer has been using the name "Reverse" in connection with its Anatomical Shoulder<sup>TM</sup> Inverse/Reverse System prosthetic devices, in which the socket and ball of the joint are reversed.

6. Because of Zimmer's use of and need for the word "reverse" to refer to such prosthetic devices, Zimmer believes it will be damaged by Registration Nos. 2,750,144 and 2,859,530.

### **III. Counts**

7. On information and belief, the term "reverse" when used in conjunction with prosthetic devices was not originated by Encore Medical.
8. On information and belief, a reverse/inverse shoulder was conceived by C.S. Neer in the early 1970's and the appellation of such devices (or procedures therefore) as "reverse" shoulders has been in use for decades.
9. The term "reverse" is at best merely descriptive of the type of prosthetic device with which the Registrant's marks are used. The device involves a prosthetic joint in which the ball and socket of the prosthesis are *reversed*. In the healthy patient, the shoulder is made up of a ball and socket joint and a rotator cuff. The ball connects to the arm; the socket connects to the shoulder blade. The rotator cuff is muscle that surrounds the joint and helps lift and rotate the arm. In patients suffering from a torn rotator cuff or arthritis, however, this protection is gone, and bone painfully scrapes against bone. Patients who receive a reverse shoulder prosthesis have the ball on the shoulder side, and the socket on the arm side – the sides of the two components of the shoulder are *reversed*.
10. Because of the descriptiveness of the marks (they directly describe without conjecture or speculation a quality of the Registrant's goods), they are inherently incapable of identifying a single source of goods.
11. Indeed, the term "reverse" is or has become generic when used to refer to the type of prosthetic device with which the marks are used. The term "reverse" is used to describe

such shoulder prostheses, and surgeries therefore, in journal articles and on the internet, without referring to Encore Medical's products.

12. The website [shouldersurgeon.com](http://www.shouldersurgeon.com) provides a list of definitions common to shoulder vocabulary. It defines "reverse shoulder prosthesis" as "an artificial shoulder joint made from metal and plastic that is used to replace a natural shoulder joint that is worn out, painful, and/or no longer functions properly. With a reverse shoulder prosthesis, the ball (humeral head) and socket (glenoid cup) are switched or "reversed." There may be advantages to using a reverse shoulder prosthesis in patients with an irreparable, massive rotator cuff tear or significant glenoid bone loss. Compare to *standard shoulder prosthesis*." [http://www.shouldersurgeon.com/shoulder\_terminology\_vocabulary/index.htm]

#### **IV. Prayer For Relief**

13. The term "reverse" is a term that Zimmer and, on information and belief, other companies need to use in order to describe the products that they manufacture.
14. Without being able to use the word "reverse" when referring to their shoulder prostheses, Zimmer would be left with no way to accurately describe the type of prosthetic shoulder device it sells. Using the phrase "shoulder prosthesis" or the like is not sufficient to describe Petitioner's particular goods.
15. Zimmer believes that it is being or will be damaged by the continued registration of the marks REVERSE and ~~Reverse~~.

WHEREFORE, Zimmer prays that Registration Nos. 2,750,144 and 2,859,530 be cancelled in their entireties, as they are generic and/or at best merely descriptive, and that this Petition for Cancellation be sustained in favor of Zimmer.

Respectfully submitted,

Dated: August 5, 2008

/Christina L. Brown  
Christina Brown  
James M. McCarthy  
Marcia Ireland Rosenfeld

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